

REMARKS

Applicant thanks the Examiner for the careful review of this application. Claims 1-3, 6-7, 9, 11-19, and 22-89 remain pending in this application.

REJECTIONS UNDER 35 U.S.C. § 112

The applicants thank the Examiner for identifying a clerical error in claim 55. The clerical error has been corrected.

REJECTIONS UNDER 35 U.S.C. § 102 and 103

Claims 1, 2, 9, 11, 12, 14-19, 22, 23, 27, 29, 31-35, 45, 46, 48-53, 57, 61-63, 69-71, 73-80, 84-89 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nummelin (U.S. Patent No. 6,308,164). Claims 3, 6, 7, 24-26, 28, 36-44, 47, 58-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nummelin, in view of Formenti (U.S. Patent No. 6,487,469). Claims 13, 30, 54-56, 64-66, 67, 68, 81, and 82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nummelin, in view of Desjardins (U.S. Pub. No. 2002/0059512). Claim 72 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nummelin, using the Examiner's personal knowledge. Claim 83 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nummelin, in view of Desjardins, in further view of Formenti. Applicant respectfully traverses for the following reasons.

The Prior Art (Nummelin)

Nummelin is not valid 102 prior art. According to 35 U.S.C. § 102:

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

With respect to 102(a), Nummelin was published upon issuance, and a patent was granted to Nummelin on October 23, 2001, while the present application was filed on January 20, 2001. Since Nummelin was published after the present application was

filed, Nummelin was not patented prior to invention, and does not qualify as prior art under 35 U.S.C. § 102(a).

With respect to 102(b), 102(c), and 102(d), the applicants respectfully assert that 102(b), 102(c), and 102(d) are not applicable.

With respect to 102(e), Nummelin was not published under section 122(b). Since Nummelin was not published under section 122(b), 102(e)(1) is not applicable. A patent was granted to Nummelin on October 23, 2001, while the present application was filed on January 20, 2001, and there is no indication that Nummelin is based on an international application. Since Nummelin was granted a patent after the filing date of the present application (and therefore necessarily before invention), 102(e)(2) is not applicable. Accordingly, Nummelin is not 102(e) prior art.

The Prior Art (Formenti)

Formenti is not valid prior art under 35 U.S.C. § 102 so it is not valid prior art under 35 U.S.C. § 103. According to 35 U.S.C. § 103:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

With respect to 102(a), Formenti was published upon issuance, and a patent was granted to Formenti on November 26, 2002, while the present application was filed on January 20, 2001. Since Formenti was published after the present application was filed, Formenti was not patented prior to invention, and does not qualify as prior art under 35 U.S.C. § 102(a).

With respect to 102(b), 102(c), and 102(d), the applicants respectfully assert that 102(b), 102(c), and 102(d) are not applicable.

With respect to 102(e), Formenti was not published under section 122(b). Since Formenti was not published under section 122(b), 102(e)(1) is not applicable. A patent was granted to Formenti on November 26, 2002, while the present application was filed on January 20, 2001, and there is no indication that Formenti is based on an international application. Since Formenti was granted a patent after the filing date of the present application (and therefore necessarily before invention), 102(e)(2) is not applicable. Accordingly, Formenti is not 102(e) prior art.

The Prior Art (Desjardins)

Desjardins is not valid prior art under 35 U.S.C. § 102 so it is not valid prior art under 35 U.S.C. § 103.

With respect to 102(a), Desjardins was published on May 16, 2002, while the present application was filed on January 20, 2001. Since Desjardins was published after the present application was filed, Desjardins was not published prior to invention, and it is not clear to the applicants that Desjardins qualifies as prior art under 35 U.S.C. § 102(a). The Examiner must establish that "the invention was known or used" in this country using the Desjardins provisional application, which was filed October 16, 2000, and may or may not include relevant teachings. Plus the applicants may or may not be able to prove invention prior to the filing date of the provisional application. Given the supplementary nature of the Desjardins reference, the applicants simply state upon information and belief that Desjardins is not 102(a) prior art, and see no reason to investigate further.

With respect to 102(b), 102(c), and 102(d), the applicants respectfully assert that 102(b), 102(c), and 102(d) are not applicable.

With respect to 102(e), Desjardins was filed on October 16, 2001, while the present application was filed on January 20, 2001. Since Desjardins was filed after the present application, 102(e)(1) is not applicable. A patent was not granted to Desjardins and, as of December 26, 2006 (according to PAIR), Desjardins has been abandoned; plus Desjardins was filed after invention by the applicants. Accordingly, Desjardins is not 102(e) prior art.

The Prior Art (Examiner's Knowledge)

At page 19 of the Office Action, the Examiner asserts:

10. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over.

Nummelin et al.

As per claim 72, Nummelin et al does not explicitly disclose the message includes a content of an online conference. However, Nummelin et al disclose transferring data between workstations 120 and 130, including email messages transferred between workstations, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the message having content from an online conference in Nummelin et al, as an additional means of transferring information between workstations 120 and 130, thereby making the system more flexible.

The Examiner has failed to show in Nummelin content of an online conference. Claim 72 depends from claim 71, which includes identity and business context data that is associated with the content of an online conference in claim 72. This is a non-trivial element that is not disclosed in the cited prior art. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide

an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See CFR 1.104(d)(2)." MPEP 2144.03 (C).

The Prior Art Distinguished

Nummelin is used as the primary reference for rejecting all of the pending claims. Since Nummelin is not 35 U.S.C. § 102 prior art, all pending claims are allowable over the cited references for at least this reason.

Formenti is used as a supplemental reference to reject claims 3, 6, 7, 24-26, 28, 36-44, 47, 58-60, 83. Since Formenti is not 35 U.S.C. § 102 prior art, claims 3, 6, 7, 24-26, 28, 36-44, 47, 58-60, 83 are allowable over the cited references for at least this additional reason.

Desjardins is used as a supplemental reference to reject claims 13, 30, 54-56, 64-66, 67, 68, 81-83. Since Desjardins is, upon information and belief, not 35 U.S.C. § 102 prior art, claims 13, 30, 54-56, 64-66, 67, 68, 81-83 are allowable over the cited references for at least this additional reason.

CONCLUSION

Applicant believes that all pending claims are allowable. Withdrawal of the rejections of all claims and a Notice of Allowance is respectfully requested. The amendment was made to expedite the prosecution of this application. Applicant respectfully traverses the rejections of the amended claims and reserves the right to re-introduce them and claims of an equivalent scope in a continuation application.

If the Examiner believes that a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned counsel at the number set out below.

Respectfully submitted,
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